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In re Application of :  
Arthur Miller :  
Application No. 29/163,203 : PETITION DECISION  
Filed: July 1, 2002 :  
Attorney Docket No. P-3455-14 :

This is a decision on the petition received November 7, 2003, which is being treated as a petition under 37 CFR 1.181, invoking supervisory authority to direct the examiner to furnish a written examiner's answer to the appeal brief filed May 2, 2003.

The petition is **Dismissed**.

### REVIEW OF THE RECORD

A review of the file reveals that an Office action was mailed on April 17, 2003 rejecting the claim on 2 separate grounds under 35 U.S.C. 112, first paragraph, and making both grounds of rejection final. The first ground of rejection under 35 U.S.C. 112, first paragraph, was based on failing to comply with the written description requirement thereof due to the introduction of new matter, and the second ground of rejection was based on lack of enablement. A notice of appeal was filed on April 30, 2003, followed by the appeal brief on May 2, 2003. A Notification of Non-Compliance with 37 CFR 1.192(c) was mailed on October 28, 2003, setting forth that 1) the brief was defective since the statement under 37 CFR 1.192(c)(6) did not refer to both grounds of rejection under 35 U.S.C. 112, first paragraph, and 2) the argument under 37 CFR 1.192(c)(8) is incomplete and incorrectly contends that the statutory basis for the final rejection is clearly improper. This petition followed.

### ISSUES FOR REVIEW

The issues that petitioner requests review of are 1) whether the appeal brief complies with subparagraphs (6) and (8) of 37 CFR 1.192(c), and 2) whether the examiner has improperly responded to the merits of the appeal brief in the Notification of Non-Compliance with 37 CFR 1.192(c).

## DECISION

### Issue 1

In the appeal brief filed May 2, 2003, under the heading "6. Issue pursuant to 37 CFR 1.192(c)(6)" only a single ground of rejection under 35 U.S.C. 112, paragraph 1, as being non-enabling is identified. The final rejection of the claim under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement thereof due to the introduction of new matter set forth in the Office action mailed April 17, 2003, has not been identified under heading "6". Therefore, the appeal brief does not include a concise statement of all issues presented for review under heading "6".

Under the heading "8. Argument pursuant to 37 CFR 1.192(c)(8)" in the appeal brief filed May 2, 2003 it's stated that "the statutory basis of the FINAL REJECTION is inapplicable to a design patent application and should be overruled." No further explanation is provided as to why appellant considers the statutory basis of the final rejection to be inapplicable. In chapter 1200 of the MPEP, section 1206, under the heading "APPEAL BRIEF CONTENT" the last sentence of paragraph 3 states: "The fact that appellant may consider a ground to be clearly improper does not justify a failure to point out to the Board the reason for that belief." Furthermore, paragraph 2 under the above heading states that "An appeal brief must be responsive to every ground of rejection stated by the examiner." Since the appeal brief does not provide any additional explanation for the contention that the statutory basis for the final rejection is inapplicable, nor any citations of authorities to support such a position, it fails to comply with 37 CFR 1.192(c)(8). In addition, the appeal brief does not point out how the drawings presently of record in the application comply with the written description and enablement requirements of 35 U.S.C. 112, first paragraph, and therefore is not responsive to every ground of rejection stated by the examiner.

The appeal brief does not comply with the requirements of 37 CFR 1.192(c)(6) and (8) and was properly indicated as being defective in the Notification of Non-Compliance with 37 CFR 1.192(c) mailed on October 28, 2003.

### Issue 2

The Notification of Non-Compliance with 37 CFR 1.192(c) mailed on October 28, 2003 identifies the defects in the appeal brief under box 9 "Other" by including a separate attachment explaining in detail why the brief fails to comply with 37 CFR 1.192(c)(6) and (8). The detailed explanation does not address the merits of the appeal brief, but rather provides a thorough description of why the arguments under heading "8" are not responsive to every ground of rejection stated by the examiner.

## CONCLUSION

1. The petition is dismissed.
2. The status of the appeal brief is defective for the reasons set forth in the Notification of Non-Compliance with 37 CFR 1.192(c) mailed on October 28, 2003.
3. Since the time periods set forth in the Notification of Non-Compliance with 37 CFR 1.192(c) have expired petitioner must file IN TRIPLICATE a complete new brief in compliance with 37 CFR 1.192(c) and a request for extension of time to avoid dismissal of the appeal.

4. Any questions with regard to this decision should be directed to John Kittle, by letter addressed to the Director, Technology Center 3700/2900, P.O. Box 1450 Alexandria, VA 22313-1450, or by telephone at (703) 308-0873.



John Kittle

Director, Technology Center 3700/2900